

REMARKS

In the Office action, restriction was required between the claims of Group I (claims 49-56 and 62-67, drawn to "a method of assembling a motor shaft with a motor component, classified in class 29, subclass 596"), and Group II (claims 57-61, drawn to "a motor shaft assembly, classified in class 464, subclass 596"). Reconsideration is respectfully requested.

The Office action characterizes the invention of Groups I and II as drawn to a process of making and the product made, respectively. Referring to M.P.E.P. § 806.05(f), the Office action states that the inventions are distinct "if either or both of the following can be shown:

- (1) that the process as claimed can be used to make other and materially different product or
- (2) that the product as claimed can be made by another and materially different process."

The Office action alleges that, in the present application, "the process can be used to make a product wherein the fan impeller is not mechanically coupled to the motor shaft."

The restriction requirement is traversed for the reasons stated below.

I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS ADMISSIONS CONCERNING PATENTABILITY

The effect of the position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the combination of Group II, and *vice versa*. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including "process and product made ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed apparatus of the Group II claims is patentable over any

disclosure of a method of assembling a motor shaft according to the Group I claims. *See, e.g.*, M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method of the Group I claims is patentable over any disclosure of a motor assembly according to the Group II claims. *Id.* Each of independent claims 49, 57, and 62 includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore “it is imperative the requirement should never be made where related inventions as claimed are not distinct.” M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

II. THE STANDARD FOR REQUIRING RESTRICTION HAS NOT BEEN MET
BECAUSE THE CRITERIA OF DISTINCTIVENESS HAVE NOT BEEN
Demonstrated

The restriction requirement is improper because the criteria of distinctiveness in M.P.E.P. § 806.05(f) have not been demonstrated. To show distinctiveness, M.P.E.P. § 806.05(f) requires either “(A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.”

Under these requirements, the restriction between Groups I and II is improper.

Independent claims 49, 57, and 62 specify substantially similar motor assembly methods and apparatus. Independent claim 49 (classified in Group I) recites a method of assembling a motor shaft with a motor component, in which a motor shaft is provided having a first end with a first surface geometry comprising a non-circular cross section. A fan impeller is installed onto the motor shaft proximate the first end of the motor shaft, a shaft extension having a first end with a second surface geometry comprising a non-circular cross section is engaged with the first surface geometry of the first end of the motor shaft, and a second end of the shaft extension is installed into a lower assembly. Independent claim 62, also classified in Group I) recites a method of assembling a motor shaft with a motor component, in which a motor shaft is provided having a first end with a threaded periphery and a first surface geometry comprising a non-circular cross section. A first washer is placed over the motor shaft first end and onto the motor shaft, a fan impeller is installed over motor shaft first end and onto the motor shaft proximate the motor shaft first end and into abutment with the first washer, and a second washer is placed over the motor shaft first end and onto the motor shaft into abutment with the fan impeller. A threaded nut is installed onto the threaded periphery of the motor shaft first end and into abutment with the second washer, and a shaft extension comprising a first end having a second surface geometry having a non-circular cross-section engages with the first surface geometry of the motor shaft first end. Finally, a second end of the shaft extension is installed into a lower assembly.

Prior to the current amendment, independent claim 57, which has been classified in Group II, specified a motor assembly comprising a motor shaft having a first end with a surface geometry comprising a non-circular cross section and a fan impeller mechanically coupled to the motor shaft proximate the motor shaft first end. A shaft extension comprising a first end having a second surface geometry with a non-circular cross section is coupled to

the first surface geometry of the first end of the motor shaft, and a lower assembly is coupled to the shaft extension.

Accordingly, each of independent claims 49, 57, and 62 specifies at least the following common elements: (1) a motor shaft having a first end with a first surface geometry comprising a non-circular cross section; (2) a fan impeller proximate the motor shaft first end; (3) a shaft extension comprising a first end having a second surface geometry comprising a non-circular cross section coupled to or engaging the first surface geometry of the motor shaft first end; and (4) a lower assembly coupled to or engaging the shaft extension. Claims 49 and 57, apart from being method and apparatus claims, respectively, are nearly word-for-word identical, the primary difference being that claim 49 recites "installing a fan impeller onto the motor shaft..." while claim 57 (as previously presented) recited "a fan impeller mechanically coupled to the motor shaft...". Claims 49, 57, and 62 all specify similar motor assembly methods and apparatus, albeit with varying breadth and scope with regards to certain features. Restriction between the claims of Groups I and II, therefore, is improper.

Furthermore, the Office action mischaracterizes the requirements to show distinctness. M.P.E.P. § 806.05(f) sets forth two alternative criteria for establishing distinctness. The Office action applies only the first criterion to the present application. In doing so, however, the Office action improperly omits one of the requirements under this first criterion. In addition to showing that the process as claimed can be used to make other and different products, it also must be shown "that the process as claimed is not an obvious process of making the product." M.P.E.P. § 806.05(f) is clear in that both of these requirements must be shown in order to meet the first criteria of distinctness. The Office action is entirely silent on whether the process as claimed is not an obvious process of

making the product, and therefore a *prima facie* showing of distinctness has not been made.

Accordingly, the restriction requirement should be withdrawn.

Applying the full distinctness test to the present claims, it is not seen that the process as claimed is not an obvious process of making the product. In this case, the "product" is the motor assembly specified in independent claim 57. The "process" is a method of assembling a motor shaft with a motor component, as specified in independent claims 49 and 62. Any difference between an impeller that is "installed on" a motor shaft (as specified in claims 49 and 62) and an impeller that is "mechanically coupled to" a motor shaft (as specified in claim 57) is so slight that it is not seen how it can be shown that the method of assembling a motor shaft according to claims 49 or 62 is not an obvious process of making the motor assembly of claim 57. Consequently, the restriction requirement is improper and must be withdrawn.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. § 803 states:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

The applicant thus further traverses the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. Instead, the examiner simply asserts that the claims of Group I would be classified in class 29, subclass 596, while the Group II claims would be classified in class 464, subclass 179. Because the subject matter of the

claims of the different groups is related, however, a complete search directed to the subject matter of Group I would require a search directed to the subject matter of the claims of Group II, and vice versa.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute these claims in separate applications. Search and examination of the two groups of claims together would be much more efficient than requiring the Patent Office and the applicants to do so separately in multiple applications.

IV. CLAIM AMENDMENT TO OBTAIN RESTRICTION REQUIREMENT

Notwithstanding the foregoing, Applicants have amended claim 57 in an attempt to advance prosecution of the application and avoid further waste of resources. Accordingly, claim 57 now specifies that the fan impeller is "installed on" the motor shaft, and therefore is identical to claims 49 and 62 in this respect. Applicants appreciate the opportunity afforded by the most recent Office action to broaden claim 57 in this manner, and submit that the no restriction is necessary between the claims as now presented. 

IV. PROVISIONAL ELECTION

To satisfy 37 C.F.R. 1.143, the applicants hereby provisionally elect for examination on the merits, with traverse, the claims of Group I, i.e., claims 49-56 and 62-67. In doing so, the applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

Respectfully submitted,

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